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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,038	09/17/1999	AKEO MARUYAMA	0557-4774-2	9584
22850	7590	01/25/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EBRAHIMI DEHKORDY, SAEID	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/398,038	Applicant(s) MARUYAMA, AKEO	
	Examiner Saeid Ebrahimi-dehKordy	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Response to Arguments

1. Applicant's arguments filed 9/28/04 have been fully considered but they are not persuasive.

Applicant argues on the response filed on 9/28/04 on page 7 line 22 and page 8 lines 1-10 and specifically lines 3-6 that the printer driver has a function to convert document data into a data format processible by an application program of an electronic mail receiver, other than PDL, so as to send the converted data Via email.

Examiner again points out Okimoto et al (U.S. patent 6,449,055), column 10 lines 30-39 and specifically lines 33-36 where the print mail transmission utility 31a creates a "print mail" and transmit the print mail to the destination data, Examiner emphasizes, column 27 lines 27-31 where the print data which is transmitted by email is automatically created in the format confirming to the type and function of the of the remote user's printer.

Examiner again points out, column 27 lines 33-39 where the desired format is chosen for example PCL. Also please note column 11 lines 44-54.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claim 1-5,7-11 and 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Okimoto et al (U.S. patent 6,449,055)

Regarding claim 1, 10 and 11 Okimoto et al disclose: An electronic mail transmitting apparatus for transmitting document data via electronic mail, said electronic mail transmitting apparatus comprising: an application program for producing document data (please note column 10 lines 17-23) said application program having a function to send a print instruction to print the document data (please note column 10 lines 23-31) and a printer driver activated by the print instruction of said application program (please note column 10 lines 26-30) said printer driver having a function to convert the document data provided by said application program into a data format processible by an application program of an electronic mail receiver and a function to transmit the converted document data via electronic mail (please note column 10 lines 30-39) where in the printer driver is capable of selecting the data format suitable for the electronic mail transmission form among the plurality of data formats other than a page description language (PDL) format (please note column 27 lines 27-32).

Regarding claim 2 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver transmits the converted document data by attaching to an electronic mail as an attachment file (please note Fig.7, column 14 lines 10-59 where the data and mail header are combined to create the email body)

Regarding claim 3 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a bit-map image format (please note column 22 lines 57-67 and column 23 lines 1-9).

Regarding claim 4 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a document reader software format (please note column 11 lines 45-55).

Regarding claim 5 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a text format (please note column 27 lines 27-32).

Regarding claim 7 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is one of a hyper text markup language (HTML) format and a standard generalized markup language (SGML) format (please note column 27 lines 26-32).

Regarding claim 8 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to manage information regarding electronic mail addresses (please note column 8 lines 28-41).

Regarding claim 9 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to edit a text of an electronic mail to be transmitted (please note column 12 lines 11-28).

Regarding claim 13 Okimoto et al disclose: The processor readable medium as claimed in claim 11, wherein said third program code means includes program code means for inputting an electronic mail address of a remote party to

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which the document data is sent via electronic mail (please note column 7 lines 28-40).

Regarding claim 14 Okimoto et al disclose: the electronic mail transmission apparatus as claimed in claim 1, wherein said printer driver includes means for determining the predetermined data format suitable for the electronic mail transmission being performed (please note column 27 lines 33-39).

Regarding claim 15 Okimoto et al disclose: the electronic mail transmission apparatus as claimed in claim 1 wherein the application program is configured to allow selection of the data format into which the document data is converted (please note column 11 lines 45-54)

Regarding claim 16 Okimoto et al disclose: the method of transmitting document data as claimed in claim 10, further comprising the step of selecting the predetermined data format in to which the document data is converted using the application program (please note column 27 lines 27-39).

Regarding claim 17 Okimoto et al disclose: the process readable medium as claimed in claim 11, further comprising fourth program code means for selecting the data format into which the document data is converted using the first program code means (please note column 10 lines 17-39).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached at (703) 305-4863.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, D.C. 20231

Or faxed to:

(703) 872-9306, or (703) 308-9052 (for **formal** communications;
please mark
"EXPEDITED PROCEDURE")

Or:

(703) 306-5406 (for **informal** or **draft** communications, please label
"PROPOSED" or "DRAFT")

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Hand delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

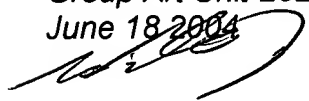
Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

Saeid Ebrahimi-Dehkordy

Patent Examiner

Group Art Unit 2626

June 18 2004



**KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER**